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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/627,270	04/04/1996	HIDEAKI TOJO	SKO-104-A-1	8796

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CARRIER, BLACKMAN & ASSOCIATES
24101 NOVI ROAD
SUITE 100
NOVI, MI 483753248

EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 08/627,270	Applicant(s) TOJO ET AL.	
	Examiner Marc Jimenez	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16, 19, 20, 27, 30-33 and 36-57 is/are pending in the application.
- 4a) Of the above claim(s) 14-16, 19, 36 and 49-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20, 27, 30-33 and 37-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>ATTACHED</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04041996</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

I. Newly submitted claims 49-57 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claims 20, 27, 30-33 and 37-48, drawn to a vehicle manufacturing method involving press-forming, classified in class 29, subclass 458.
- II. Claims 49-57, drawn to a method of protecting a painted exterior surface, classified in class 427, subclass 154.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require “applying paint to a plurality of vehicle body components” or “wherein no additional paint is applied to the vehicle after the protective coating has been applied” as recited in the subcombination. The subcombination has separate utility such as for use in a combination other than one having “press-forming panel parts from a sheet metal and welding the panel parts together” as recited in the combination.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

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on the merits. Accordingly, claims 49-57 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Drawings

3. The drawings are objected to because figure 8 as described in the specification is missing from the application file that the examiner is working on. It is noted that the pre-grant publication of this application US 2003/0163910 also did not have figure 8. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The amendment filed 3/27/03 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows (see also last office action mailed 9/12/03):

(a) the LAPGUARD L is a peelable paint, and

(b) that the protective film formed in said peelable paint coating step has a sufficient thickness to protect the paint finished automobile body from scratches during the assembling.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 20, 27, 30-33 and 37-48** are rejected under 35 U.S.C. 103(a) as being unpatentable over Grogan et al. (US5604282) in view of Omori et al. (US4727232) or vice versa.

Regarding claims 20, 47 and 48, Grogan et al. teach painting an automobile body so that the automobile is paint-finished (col. 1, line 59 and 66-67 and col. 2, line 21), assembling an engine and functional parts into the paint-finished automobile body to thereby produce an assembled automobile (col. 1, lines 54-58) col. 2, line 4), and after the automobile is completely

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manufactured performing a final inspection of the assembled automobile (it is clearly inherent that when manufacturing vehicles, a final inspection is performed before the vehicles are shipped), wherein the method further includes, between the painting and the assembling steps, coating a strippable paint on an exterior painted surface of the paint-finished automobile body (col. 5, lines 49-51) to thereby form a protective film on the painted surface, and at least the assembling step and the final inspection step are carried out while the protective film of the strippable paint remains coated on the painted surface of the paint-finished automobile body (col. 5, lines 51-58).

Grogan et al. states “A need exists for a water-removable coating composition to protect the automobile against weathering, contamination from the atmosphere, chemical attack or accidental damage during manufacturing, handling, storage and transit.” (col. 1, lines 54-60).

The manufacturing would include the assembling of the engine and functional parts into the automobile body. Also, in col. 2, lines 46-48, Grogan et al. states “Thus, there is a need from a tough film that is inexpensive to apply and remove and one that can remain on the vehicle until the consumer purchases the car.”. Also, in col. 10, lines 4-7, Grogan et al. states “During assembly of the vehicle, the paint finish is inadvertently dinged, chipped and scratched as the workers use their tools to assemble the various parts of the vehicle.” (This applies to claim 46). Therefore, the protective film **remains** on the vehicle during assembly, during transit, and is only removed at the final destination. Before vehicles are placed in transit, there is a “final inspection”, for example, because each vehicle must be checked to ensure that the proper vehicle is transported. (These teachings read on claim 45).

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Grogan et al. fails to teach that the automobile parts are formed by press forming panel parts from sheet metal and welding the panel parts together to form an automobile body.

Omori et al. teach that surfaces of an automobile vehicle body are conventionally formed by press forming, welding and painting (col. 1, lines 12-59).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Grogan et al. with the steps of forming by press forming and then welding them, in light of the teachings of Omori et al., in order to securely fasten parts together and in order to accurately form the desired contour of the vehicle.

In the alternative, and also based on the teachings of the two references, it would have been obvious to one of ordinary skill in the art, at time of the invention, to modify the method of Omori et al., to coat the automobile with a peelable paint after it has been painted, in order to protect the vehicle from damage during subsequent mechanical operations performed on the product, as taught by Grogan et al.

Regarding claims 27 and 41-44, Grogan et al. is considered to teach a preliminary drying of the strippable paint as the strippable paint is first dried. There is a non-preliminarily drying the preliminarily dried, strippable paint using a second drying means in the wind tunnel (col. 5, line 48).

Regarding claim 30, the use of infrared radiation in conjunction with hot air is a well known expedient to drying coatings and official notice is taken of such. Consequently, it is considered that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify the combination as explained above so as to dry the peelable coating by infrared radiation in conjunction with hot air.

Regarding claims 31, 32 and 40 neither Grogan et al. nor Omori et al. explicitly teach that the peelable paint is stabilized prior to drying and that this is done at ambient conditions. It is the examiners position that ambient conditions would have been the most readily apparent and convenient condition to one of ordinary skill in the art, requiring no modification of the surrounding environment. Consequently, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to apply peelable paint under ambient conditions because ambient conditions would have been the most constant and time effective conditions available to do so. Any point prior to drying at which the peelable paint coated product sits at ambient (for any period of time) reads on the claimed stabilizing treatment.

Regarding claims 33 and 37, Grogan et al./Omori et al. teach the invention cited with the exception of the drying steps being performed at elevated temperatures. However, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have provided the invention of Grogan et al./Omori et al. with drying at elevated temperatures, in order to facilitate faster drying of the protective film.

Regarding claims 38 and 40, the strippable paint is water based (col. 5, line 31).

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 20, 27, 30-33 and 37-48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8, 63, 65, 9, 36-38, 12 and 66 of copending Application No. 08/398,881.

See last office action where the double patenting rejection was applied at page 10 of the office letter mailed 9/12/03. Applicant has not addressed the double patenting rejection in the last office.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

9. Applicant's arguments with respect to claims 20, 27, 30-33 and 37-48 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number (571) 272-4530. The examiner can normally be reached on Monday-Friday between 5:30 a.m.-2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ
August 5, 2005


MARC JIMENEZ
PRIMARY EXAMINER
8/5/05